

REMARKS

Claims 1 through 17 are pending in this application. Claims 8 and 17 are amended in several particulars for purposes of clarity in accordance with current Office policy, to assist the examiner and to expedite compact prosecution of this application.

REJECTION OF CLAIMS (35 U.S.C. § 103)

On page 2 through 3 of Paper No. 6, claims 1 through 17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sukurai (U.S. Patent No. 5,581,685) in view of Miyashita (U.S. Patent No. 6,186,630).

Respectfully, according to MPEP 706.02(j), the examiner did not establish a *prima facie* case of obviousness under 35 U.S.C. §103.

The examiner on page 2 of paper number 9 in the responses to arguments states that Sakurai does disclose an indicator initially displayed at a predetermined position within a menu as shown in col. 9, lines 47-57 which mentions an area indicator which is increased and decreased by one for the display of the submenu and for a display of a previous menu. The examiner then conjectures that it would have been obvious to locate a predetermined position by increment/decrement method.

The applicant respectfully disagrees with the examiner's response. First, as seen in figure 13A of Sakurai, the indicator is outside the menu area, not within as mentioned in claim 1 for instance. The indicator being inside the menu is important because, as mentioned in the specification of the present invention, it saves time and effort of moving the indicator with the input

device.

Second, there is no teaching of a predetermined initial position by Sakurai. A specific initial position is never mentioned in Sakurai. Col. 9, lines 47-57 for instance are only mentioning the increasing or decreasing of the levels of the menu with its submenus.

Third, respectfully, it would be improper to conjecture that an initial predetermined position being displayed is obvious based on the increment/decrement method. This is a conclusory statement that does not teach or suggest the limitation. An incrementing or decrementing method does not teach or suggest an initial predetermined position. For example, an initial position of an indicator can be arbitrary and still have the incrementing or decrementing method used to keep track of the levels of the menus.

Concerning claim 8, there is no mention by the examiner concerning the limitation of "said indicator able to position to anywhere on said display screen." In Sakurai, the indicator has a fixed motion related only to the menu only as seen for example on figure 13A of Sakurai. Miyashita also does not teach or suggest the indicator being able to position anywhere on the display screen. The examiner mentions col. 1, lines 52-56 and col. 3, lines 5-10 in that the operator can freely control the display position of the position mark by a remote controller. However, a close look at the sections only mentions the pointing device of the hand-held remote controller used to change the display position of the cursor to match the progress of the presentation, which is not teaching or suggesting free movement in the entire display area. The ability to move in the whole area is important because as mentioned in the specification, it is this freedom that also causes the problems

of having to move to a menu area each time, thereby wasting time. Evidently, both Miyashita and Sakurai do not have such a problem to be corrected. Even if we assume that the combination does allow free movement of the cursor in the entire display area, still the combination is not teaching or suggesting an indicator that can both move freely on the entire display area and automatically adjust the display of the indicator to be on the menu. The problem of the freely moving indicator is not shown and there is no attempt to solve such a problem. The Federal Circuit has mentioned that “[t]he test for obviousness is not whether the features of one reference may be bodily incorporated into another reference...Rather, we look to see whether combined teachings render the claimed subject matter obvious.” *In re Wood*, 599 F.2d 1032, 202 USPQ 171, 174 (CCPA 1979) (citing *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549-50 (CCPA 1969); *In re Mapelsden*, 329 F.2d 321, 322, 141 USPQ 30, 32 (CCPA 1964).

On page 4 of paper number 9, the examiner states that regarding claims 3, 6, 7, 11, 12, and 15 Miyashita teaches about an enlargement of an image, and changing the position of a cursor using a remote controller. col. 3, line 10-17. For example in claim 7, however, it states that the changing of the position and size of the menu locates the indicator to the stored location. In claim 11 for example states that after changing a position and size of said menu, the indicator automatically follows the menu. A close reading of col. 3, line 10-17 states that “when a system is constructed using a liquid crystal projector as the projecting means and a personal computer as a main control means...an enlargement of an image produced by the personal computer...a presenter can change the display position of the position mark (e.g., cursor) to match the progress of the presentation.” It is

stating that while there is an enlargement, a presenter manually changes the display position of the cursor to match the progress of the presentation. This statement is not teaching or suggesting the indicator going to a stored location when there is a change size and position of the menu. Only the manual change of position of the cursor to match the progress of the presentation is mentioned. Miyashita is only allowing a user to manually manipulate the cursor during presentation.

Concerning claim 15, the examiner makes no mention how the combination teaches or suggests the menu being separated from an image signal generated on the display screen. There is only a mention concerning the enlargement of an image.

Concerning claim 14, the combination does not teach or suggest the menu overlapping an image signal generated on the display screen of a television. In Sakurai, as seen in figure 13A for example, only a menu is shown. In Miyashita, there is a mention of a menu, but nothing is taught or suggested that the menu is overlapping an image signal of a television.

Concerning claims 9-10, the examiner states that Miyashita teaches about a projection system where the position can be controlled apart from the main control means and that an operator can freely control the display position of the position mark. However, this teaching does not mention where the "indicator is initially located in the center of said first menu item." or as mentioned in claim 10, that the indicator locates back to the center of the stored location of the menu. The explanation given by the examiner, respectfully, does not address the limitations. The free control of the indicator does not teach or suggest the initial location in the center of the menu or going back to the center of a stored location. If a user moves the indicator to the center, then it no longer is an

initial position. The manual manipulation of moving the indicator to the center is precisely the kind of activity that the present invention is trying to help correct. As mentioned in the present invention, the manual movement of the cursors from one area to another wastes time and energy, and the present invention is trying to correct this by having the cursor initially located in the center and when a menu is erased, it locates back to the center of the stored location which again saves time and energy. Miyashita is actually teaching away from the present invention by forcing one to move the indicator manually by a user.

Claim 17 also mentions the indicator being on a center point of selected submenu which the combination does not teach or suggest. As mentioned above, the center location helps to save time in moving the cursor.

Concerning claim 16, the examiner states that Miyashita teaches an equivalent screen display. The present invention concerns televisions and as mentioned in claim 16 a cathode ray tube. Miyashita, is not analogous to the present invention, and should be combined with Sakurai. Miyashita concerns a projector that projects on a screen with a signal provided by a separate personal computer. This is quite different from the compact television of the present invention. A projector screen by its very nature cannot be cathode ray tube, if it was then no image can be viewed by the projector. As mentioned in MPEP 706.02(j), "there must be a reasonable expectation of success." Having a cathode ray tube for projector screen would not be successful. If the cathode ray tube were to replace the projector and screen, then Miyashita no longer concerns the subject matter of a

projector. The prior art references of Miyashita, must show substantially the same function in substantially the same way to achieve substantially the same result, and only then will the reference be considered an equivalent of the claimed invention to support an obviousness rejection. Hilton Davis Chemical Co. v. Warner-Jenkins co. 62 F.3d 1512, 35 USPQ 2d 1641, 1645 (Fed. Cir, 1995), *See* Pennwalt Corp. v. Durand-Wayland, Inc., 833 F.2d 931, 4 USPQ 2d 1737 (Fed. Cir. 1987) (*en banc*). As shown above, the projector screen of Miyashita does not show substantially the same function in substantially the same way to achieve substantially the same result. All these criteria are not met.

Therefore, Miyashita does not teach or suggest the cathode ray tube of the present invention.

The examiner states that one would have been motivated in view of the suggestion in Miyashita that the desired manually operated remote controller is equivalent to Miyashita's remote controller, and the use of which helps for wirelessly transmitting an operation signal as taught by Miyashita. Respectfully, the motivation mentioned by the examiner is then clearly showing improper hindsight reconstruction. As mentioned strongly in the recent United States Court of Appeals for the Federal Circuit decision in *In Re Sang Su Lee*, docket number 00-1158 (serial number 07/631,240), decided January 18, 2002, the court stated that the "particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). The court further stated, that the examiner can satisfy the

burden of showing obviousness of the combination “only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.” *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999). The fact that the examiner is looking to the present invention to see if the remote control is equivalent to the remote control in Miyashita in order to show the motivation to combine with Sakurai is then improper according to the *Dembiczak* court, using the present invention as a “blueprint for piecing together the prior art to defeat patentability” and the *In Re Sang Su Lee* and *In re Kotzab* courts, by improperly using knowledge of the claimed invention to select components for combination in the manner claimed.

JP7-234772 was included in a Japanese Office action which was included in the IDS filed with the USPTO. One exemplary difference between JP7-234772 and the presently claimed invention is that JP7-234772 concerns a cursor and menus in a computer system while the present invention can include the indicator and menus in a television. JP7-234772 is not analogous to the present invention.

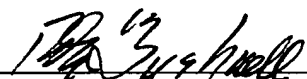
Claims 8 and 17 are amended only to clarify the lexicography of the claims, set forth in the specification that shows a television set. see *Hockerson-Halberstadt, Inc. v. Converse Inc.*, 183 F.3d 1369, 1375, 51 USPQ2d 1518, 1522 (Fed. Cir. 1999).

Respectfully, entry of the foregoing amendments to claims 8 and 17 is proper under 37 C.F.R. 1.116(b) because those amendments simply respond to the issues raised in the final rejection, no new issues are raised, no further search is required, and the foregoing amendments are believed to remove the basis of the outstanding rejections and to place all claims in condition for allowance. The foregoing amendments, and explanations, could not have been made earlier because they are merely responsive to issues newly raised in Paper No. 9.

In view of the foregoing amendments and remarks, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. If there are any questions, the examiner is asked to contact the applicant's attorney.

No fee is incurred by this Amendment. However, should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Please amend claims 8 and 17, as follows:

1 8. (Amended) A method, comprising the steps of:
2 a menu key on a remote controller being pressed to display a menu on a display screen of a
3 television, an initial position of an indicator being in an area of said menu, said indicator able to
4 position to anywhere on said display screen;
5 moving said indicator to a menu item location using a trackball on said remote controller[,];
6 selecting said menu item with a selection key on said remote controller;
7 storing location of said menu item;
8 performing a function of selected menu item;
9 displaying a sub menu of said menu;
10 said indicator positioning to a location of said sub menu;
11 selecting an item in said submenu;
12 performing function of said sub menu;
13 erasing said sub menu; and
14 automatically adjusting display of said indicator to display said indicator on said screen at
15 said location of said menu item.

1 17. (Amended) A television [An] apparatus, comprising:

2 a trackball on a remote controller for controlling the movement of an indicator on a television
3 display screen relative to a predetermined initial position of said indicator on the screen to select a
4 displayed menu item;

5 a trackball movement sensor sensing a shift value of the movement of said trackball along
6 X-Y coordinates relative to the predetermined initial position of said indicator;

7 a selection key which selects said menu items;

8 a menu key which displays said menu on [a] said television display screen;

9 a shift value data storage unit accommodating the storing shift value data corresponding to
10 the movement of said trackball relative to the initial indicator position;

11 a control commander selecting the control function corresponding to said menu item where
12 said indicator is located when said selection key is activated;

13 a data generator , responsive to said remote controller for generating data corresponding to
14 the stored shift value of said trackball received from said shift value data storage unit when said
15 remote controller is activated; and

16 a transmitting means accommodating coding and transmitting data from said data generating
17 means to an electrical appliance; and

18 wherein said electrical appliance comprises:

19 a receiver accommodating the data transmitted by said transmitting means;

20 a display control unit, connected to said receiver, displaying a menu on said television

21 display [portion] screen according to said received data;
22 an indicator display, said indicator display unit displays said indicator in a center point of a
23 selected submenu;
24 said television display screen ;
25 a microprocessor; and
26 a menu storage means, connected to said display control unit, for providing data which is
27 displayed on said television display [portion] screen.